



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Robert M. Zeidman

Examiner: Schnurr, John R.

Serial No.: 09/767,819

Group Art Unit: 2623

Filed: January 22, 2001

Docket: Zeid-02

For: Method For Advertisers to Sponsor Broadcasts Without Commercials

APPEAL BRIEF UNDER 37 CFR § 41.37

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Commissioner for Patents
P.O. Box 1450
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Sir:

This Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on March 31, 2009, and in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed May 19, 2009 and the Final Rejection of claims 1-10 in the above-identified application, as set forth in the Final Office Action mailed on February 4, 2009.

A check in the amount of \$270.00 is included herewith, which represents the requisite small entity fee set forth in 37 C.F.R. § 41.20(b)(2). The Appellant respectfully requests consideration and reversal of the Examiner's rejections of the pending claims.

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the inventor, Robert M. Zeidman.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to Appellant that will have a bearing on the Board's decision in the present appeal.

3. STATUS OF THE CLAIMS

The application was filed with claims 1-10 on January 22, 2001. A first non-final office action was mailed on August 12, 2004 rejecting all 10 claims. Claims 1-10 were amended in the response to the first non-final office action filed on February 15, 2005. A first final office action was mailed on June 29, 2005 rejecting all 10 claims. Claims 1-10 were amended in the response to the first final office action filed on August 24, 2005 with a Request for Continued Examination.

A second non-final office action was mailed on October 4, 2005 rejecting all 10 claims. Claims 1-3, 5, and 7-10 were amended in the response to the second non-final office action filed on December 19, 2005. A second final office action was mailed on March 27, 2006 rejecting all 10 claims. The Applicant filed a response to the second final office action on March 27, 2006. An Advisory Action was mailed on June 12, 2006. The Applicant filed a Notice of Appeal on July 6, 2006. The Applicant filed an Appeal Brief on August 21, 2006.

In response to the Appeal Brief, prosecution was re-opened and a third final office action was mailed on December 18, 2006 rejecting all 10 claims. Claims 1-10 were amended in the response to the third final office action filed on February 15, 2007 with a Request for Continued Examination.

A third non-final office action was mailed on April 23, 2007 rejecting all 10 claims. Claims 1-10 were amended in the response to the third non-final office action filed on July 23, 2007. A fourth final office action was mailed on November 13, 2007 rejecting all 10 claims. Claims 1-10 were amended in the response to the fourth final office action filed on January 12, 2008 with a Request for Continued Examination.

A fourth non-final office action was mailed on March 19, 2008 rejecting all 10 claims. Claims 1-10 were amended in the response to the fourth non-final office action filed on May 27, 2008. A fifth non-final office action was mailed on August 29, 2008 rejecting all 10 claims. Claims 1-10 were amended in the response to the fifth non-final office action filed on November 13, 2008. A fifth final office action was mailed on February 4, 2009 rejecting all 10 claims. The Applicant filed a Notice of Appeal on March 31, 2009. This Appeal Brief is filed in connection with the current appeal.

The current status of the claims is: claims 1-10 stand rejected five times in non-final office actions, rejected five times in final office actions, remain pending, and are the subject of the present appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action dated February 4, 2009.

5. SUMMARY OF CLAIMED SUBJECT MATTER

This summary is presented in compliance with the requirements of Title 37 C.F.R. § 41.37(c)(1)(v), mandating a “concise explanation of the subject matter defined in each of the independent claims involved in the appeal ...”. Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims in any way.

Independent Claim 1 (FIG's. 1-3, 6-9; Appellant's Specification, at page 4, lines 13-26; page 6, lines 4-10, and 22-31)

Some embodiments of the Application are related to a method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast. The method includes: receiving a broadcast (301) with embedded information (302) about the broadcast, said embedded information being provided to allow construction of a viewing record of the broadcast, the embedded information including information indicative of one or more sponsors of the broadcast; extracting and displaying content from said broadcast (301) without commercial interruption to a viewer; extracting said embedded information (302) from said broadcast; storing said embedded information; collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives (900-902) being associated with the amount of the broadcast viewed by the viewer, wherein the collected viewer information is not collected in response to prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program; sending said stored embedded information and viewer information to a remote computer (103) to allow said remote computer to construct said viewing record; and providing the specific incentives (900-902) to the viewer based on said viewing record, the viewing record including viewer information obtained without prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program, the specific incentives (900-902) including information indicative of one or more sponsors of the broadcast.

Independent Claim 2 (FIG's. 1-3, 6-9; Appellant's Specification, at page 4, lines 13-26; page 6, lines 4-39; page 7, lines 1-10, and 30-36)

Some embodiments of the Application are related to a method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast. The method includes: receiving a broadcast (301) with information (302) about the broadcast embedded into the broadcast at regular time periods, said information including timestamps (602) each identifying a time slice during which the broadcast is received, the embedded information including information indicative of one or more sponsors (601-602) of the broadcast; extracting and displaying content from said broadcast (301) without commercial interruption to a viewer; extracting said embedded information (302) from said broadcast; incrementing counters (704) for counting time slices during which said broadcast is received; storing said embedded information and said counter values (707); collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives (900-902) being associated with the amount of the broadcast viewed by the viewer, wherein the collected viewer information is not collected in response to prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program; sending said embedded information, said counter values and viewer information to a remote computer (103) to allow a viewing time to be determined; and providing the specific incentives (900-902) to the viewer based on said embedded information and the viewer information obtained without prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program, the specific incentives including information indicative of one or more sponsors of the broadcast.

Independent Claim 3 (FIG's. 1-3, 6-9; Appellant's Specification, at page 4, lines 13-26; page 6, lines 4-10, and 22-31)

Some embodiments of the Application are related to a method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast. The method includes: embedding information (302) along with the broadcast content (301), said embedded information including information that allows

viewer information to be determined, the viewer information including information indicative of an amount of the broadcast viewed by a remote viewer, specific incentives and links to the specific incentives (900-902) being associated with the amount of the broadcast viewed by the remote viewer, the embedded information (302) including information indicative of one or more sponsors of the broadcast; and broadcasting said content (301) with said embedded information (302) to the remote viewer of the content without commercial interruption, the embedded information enabling a remote computer to retain the information indicative of one or more sponsors of the broadcast, and to determine the viewer information, the viewer information further including a user identifier and the information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives (900-902) being based in part on the amount of the broadcast viewed by the remote viewer, wherein the viewer information is not determined in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

Independent Claim 5 (FIG's. 1-3, 6-9; Appellant's Specification, at page 4, lines 13-26; page 6, lines 4-10, and 22-31)

Some embodiments of the Application are related to a method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast. The method includes: embedding information (302) along with the broadcast content (301) at regular time periods, wherein said embedded information, when collected over time, allows a viewing record of the broadcast to be determined, the embedded information including information indicative of one or more sponsors of the broadcast; and broadcasting said content (301) with said embedded information (302) without commercial interruption to a remote viewer of the content, the embedded information enabling a remote computer to retain the viewing record, information indicative of one or more sponsors of the broadcast, and viewer information, the viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives and links to the specific incentives (900-902) being associated with the amount of the broadcast viewed by the remote viewer, wherein the viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer

participation in an interactive reward program.

Independent Claim 7 (FIG's. 1-3, 6-9; Appellant's Specification, at page 4, lines 13-26; page 6, lines 4-39; page 7, lines 1-10, and 30-36)

Some embodiments of the Application are related to a method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast. The method includes: receiving information representing a viewing record (600-602) including information related to a viewer's viewing of a broadcast without commercial interruption, the viewing record including information indicative of one or more sponsors of the broadcast and viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives (900-902) being associated with the amount of the broadcast viewed by the viewer, wherein the viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of viewer participation in an interactive reward program; and sending the links to the specific incentives (900-902) to the viewer based on said viewing record including information indicative of one or more sponsors of the broadcast, the viewing record including viewer information obtained without prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program.

Independent Claim 8 (FIG's. 1-3, 6-9; Appellant's Specification, at page 4, lines 13-26; page 6, lines 4-39; page 7, lines 1-10, and 30-36)

Some embodiments of the Application are related to a method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast. The method includes: receiving information (801) about a remote viewer's viewing of a broadcast without commercial interruption, the received information including information indicative of one or more sponsors of the broadcast; receiving counter values (707) representing the number of time slices viewed by the remote viewer; collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives (900-902) being associated with the amount of the broadcast viewed by the viewer, wherein the

collected viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program; and sending specific incentives (900-902) to the remote viewer based on said information received, including information indicative of one or more sponsors of the broadcast, and said counter values received, said information received being obtained without prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

Independent Claim 9 (FIG's. 1-3, 6-9; Appellant's Specification, at page 4, lines 13-26; page 6, lines 4-39; page 7, lines 1-10, and 30-39; page 8, lines 1-11)

Some embodiments of the Application are related to a method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast. The method includes: receiving information representing a viewing record (600-602) including information related to a remote viewer's viewing of a broadcast without commercial interruption, the viewing record including information indicative of one or more sponsors of the broadcast, the viewing record further including information indicative of a user identifier and information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives and links to the specific incentives (900-902) being associated with the amount of the broadcast viewed by the remote viewer, wherein the information representing a viewing record is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program; searching a database for information (803) about sponsors of the content of said broadcast and the specific incentives offered by said sponsors; creating a Web page (804) containing links to sponsor incentive websites and to specific incentives based on said database information and said viewing record; and sending (805) said Web page to said remote viewer.

Independent Claim 10 (FIG's. 1-3, 6-9; Appellant's Specification, at page 4, lines 13-26; page 6, lines 4-39; page 7, lines 1-10, and 30-39; page 8, lines 1-11)

Some embodiments of the Application are related to a method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives

to viewers to watch the broadcast. The method includes: receiving information representing a viewing record (600-602) including information related to a remote viewer's viewing of a broadcast without commercial interruption, the viewing record including information indicative of one or more sponsors of the broadcast and viewer information including information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives and links to the specific incentives (900-902) being associated with the amount of the broadcast viewed by the remote viewer, wherein the viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program; receiving counter values (707) representing the number of time slices during which the broadcast was viewed by said remote viewer; searching a database for information (803) about sponsors of the content and the specific incentives offered by said sponsors; creating a Web page (804) containing links to sponsor incentive websites and to specific incentives based on said database information, said viewing record, and said counter values; and sending (805) said Web page to said remote viewer.

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellant refers to each of the appended claims and its legal equivalents for a complete statement of the claimed embodiments of the invention.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the 1997 Broadcast of “Schindler’s List” on NBC in view of Matheny et al. (U.S. Patent No. 6,766,524), hereinafter “Matheny”; and further in view of Blackketter et al. (U.S. Patent No. 7,103,904), hereinafter “Blackketter”; and further in view of Williams et al. (U.S. Patent No. 6,075,971), hereinafter “Williams”.

7. ARGUMENT

A) §103 Rejection of the Claims

The Appellant does not admit that Matheny or Blackketter are prior art, and reserves the right to swear behind these references in the future. In addition, since a *prima facie* case of obviousness has not been established, the Appellant respectfully traverses this rejection.

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper "functional approach" to the determination of obviousness as laid down in *Graham* [*Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966)]. The key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Court held that the TSM test under *Graham* must be applied flexibly, and take into account a number of factors "in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed." Despite this flexibility, however, the Court stated that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does." The Supreme Court in *KSR* also noted that the analysis supporting a rejection under 35 U.S.C. §103 should be made explicit. See also M.P.E.P. § 2142. Moreover, a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. *KSR*. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR*).

Exemplary rationales that may support a conclusion of obviousness as set forth by Supreme Court in *KSR* and by the Patent Office's own procedural rules (see M.P.E.P. § 2143) include:

(A) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention (*Graham*). However, if a proposed modification would render the prior art

invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959);

(B) Combining prior art elements according to known methods or simple substitution of elements to yield predictable results. As explained in *KSR*, "A rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known*** in the prior art and one skilled in the art could have combined the elements as claimed by known methods ***with no change in their respective functions***, and ***the combination would have yielded nothing more than predictable results*** to one of ordinary skill in the art." Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976);

(C) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success. The rationale to support a conclusion that the claim would have been obvious is that "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103. (*KSR*). If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art; and

(D) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art. The rationale to support a conclusion that the claimed invention would have been obvious is that design incentives or other market forces could have prompted one of ordinary skill in the art to vary the prior art in a predictable manner to result in the claimed invention. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. See *Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing *In re Royka*, 490 F.2d 981 (CCPA 1974)). "Mere identification in the prior art of each element is insufficient to defeat the patentability of the

combined subject matter as a whole.” *In re Kahn*, 441 F.3d 977, 990, 78 USPQ2d 1329, 1338. (Fed. Cir. 2006).

The Examiner Did Not Apply the Proper Obviousness Standard in Assessing the Patentability of the Pending Claims -

As detailed above, the Supreme Court in *KSR* and the MPEP § 2142-2144 set forth a standard for assessing the patentability of claims in view of alleged §103 obviousness. However, these standards were not applied in the review of the present application. The Final Office Action of February 4, 2009 at page 3 asserts in its rejection based on ‘Shindler’s List’ and Matheny that, “Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the teachings of Matheny et al. with other types of programming including ‘broadcasts without commercial interruption’ for the purpose of providing a means to encourage viewers to pay attention to TV programs.” (emphasis added). However, in stark contrast to the Examiner’s assertion in the Office Action, Matheny states in its abstract, “Described are methods and apparatus for encouraging viewers to pay attention to television programs, commercials in particular, by offering viewers some incentive to watch.” (emphasis added). Matheny’s explicit purpose for encouraging viewers to pay attention to television programs, commercials in particular, is inconsistent with the alleged purpose of encouraging viewers to pay attention to television programs without commercials as offered by the Examiner in the Office Action. Thus, the purported basis for combining ‘Shindler’s List’ and Matheny is not found in or supported by the cited references. Rather, the asserted basis apparently emanates from the Examiner’s own hindsight reasoning and not from any suggestion or motivation offered in the cited references. Further, no evidence is offered that the result of this combination of references with no change in function would have been predictable at the time the presently claimed invention was made. Additionally, no attempt is made to characterize the state of the art or the knowledge one of ordinary skill in the art would have had at the time the invention was made. Others of the obviousness rejections made in the Final Office Action also suffer from a similar lack of reasoned analysis and appropriate rationale based on the knowledge one of ordinary skill in the art would have had at the time the invention was made. As such, none of the appropriate obviousness rationales set forth by the Supreme Court in *KSR* and the MPEP § 2142-

2144 have been applied to the obviousness analysis offered in the Office Action. Therefore, the Examiner has failed to establish a proper *prima facie* case of obviousness by failing to apply the appropriate standards for an obviousness determination. Thus, reconsideration and reversal of the rejections under 35 USC § 103(a) is respectfully requested.

Combining the References Does Not Provide All Claimed Elements -

No proper *prima facie* case of obviousness has been established because no suggested modification or combination of Schindler's List, Matheny, Blackketter, and/or Williams provides for "collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer, wherein the collected viewer information is not collected in response to prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program; ... and providing the specific incentives to the viewer based on said viewing record, the viewing record including viewer information obtained without prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program, the specific incentives including information indicative of one or more sponsors of the broadcast," as claimed by the Appellant in pending Claim 1. The remaining pending claims include similar elements. As explained below and with reference to the Examiner's own admissions from various office actions, Matheny in combination with Schindler's List, Blackketter, or Williams does not teach or suggest at least these elements of the pending claims.

"[Schindler's List] provides evidence that it is known in the art of television broadcasting to 'allow content to be broadcast without commercial interruption' yet still be sponsored by companies. However, the evidence of the particular species of 'broadcast programming' is silent with respect [to] further providing incentives to viewers to watch." (Feb. 4, 2009 Final Office Action, pg. 2). Further, Schindler's List is silent on providing incentives without prompting the user for feedback.

"Matheny provides specific incentives or rewards to the viewer based on said viewing record including information indicative of one or more sponsors of the broadcast. ... It is unclear from Matheny et al. whether or not the 'embedded information includes information indicative of

one or more sponsors of the broadcast’ such as a sponsor name. ... The system further ‘collect[s] viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer’ (Figures 2-4 col. 3 line 46 to col. 4 line 48).” (Feb. 4, 2009 Final Office Action, pg. 3). Further, Matheny is also silent on providing incentives without prompting the user for feedback.

“Blackketter et al., in conjunction with its usage of advertising templates teaches that it is known in the art for ‘embedded information’ such as triggers to ‘include information indicative of one or more sponsors of the broadcast’ such as the sponsor name. ... However, the above combination does not specifically teach collecting the viewer information without prompting the user for feedback.” (Feb. 4, 2009 Final Office Action, pg. 3). Further, Blackketter is silent on providing specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer.

“Williams et al. discloses providing coupons to a network device without prompting the user for feedback. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination of Matheny et al. and Blackketter et al. using the teachings of Williams et al. for the purpose of gathering user data without interruption.” (Feb. 4, 2009 Final Office Action, pg. 3). However, Williams is silent on providing specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer. Williams is also silent on providing specific incentives including information indicative of one or more sponsors of the broadcast.

As admitted in the current and prior office actions, the combination of Schindler’s List, Matheny, and Blackketter does not teach collecting viewer information without prompting the user for feedback (e.g., see Final Office Action at pg. 3). In fact, Matheny teaches a system and method that requires viewer feedback as part of the reward validation and fulfillment process; yet, Matheny was offered in the Final Office Action as the primary reference allegedly teaching many of the pending claim elements, including specific incentives or rewards based on sponsors of the broadcast. As described in Matheny, “viewers must provide some feedback to indicate that they watched the commercial before they are entitled to a reward.” See Matheny, col. 3, lines 14-30, emphasis added. As such, Matheny teaches a system implemented to require such prompted

viewer feedback from the viewer as part of viewer participation in an interactive reward program. This teaching of required viewer feedback in Matheny is directly opposite of and inconsistent with the approach presently claimed, wherein the pending claims specifically recite that, “viewer information is not collected in response to prompted viewer feedback”.

Matheny was also offered in the Final Office Action as the primary reference allegedly teaching ‘collecting viewer information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer’. However, the portion of Matheny cited in the current and prior office actions as support for this element teaches, “if a viewer answers question 269, then set-top box 245 notes the identity of the program in which the question appeared, the time the question was posed, a value expressing how much of the program was viewed.” See Matheny, Figures 2-4, col. 3, line 46 to col. 4, line 48, emphasis added. Thus, Matheny teaches a system that only notes a value expressing how much of the program was viewed when a viewer answers a question. In Matheny, if no viewer feedback is received, no value expressing how much of the program was viewed is retained. Again, this teaching of collecting viewer information indicative of an amount of the broadcast viewed by the viewer in Matheny is based on user feedback and directly opposite of and inconsistent with the approach presently claimed, wherein the pending claims specifically recite that, “viewer information is not collected in response to prompted viewer feedback.” Schindler’s List, Blackketter, and Williams do not teach a system for collecting viewer information indicative of an amount of the broadcast viewed by the viewer; thus, only the teachings in Matheny can support a rejection of this claim element. However, Matheny only teaches a system that requires prompted viewer feedback before a value expressing how much of the program was viewed is noted.

In summary, the combination of Schindler’s List, Matheny, and Blackketter does not teach a system that collects viewer information without prompting the user for feedback. Williams is silent on providing specific incentives and links to the specific incentives associated with the amount of the broadcast viewed by the viewer and including information indicative of one or more sponsors of the broadcast. Therefore, the Examiner has failed to establish a proper *prima facie* case of obviousness by failing to demonstrate that each of the claimed elements is

taught in the cited references. Thus, reconsideration and reversal of the rejections under 35 USC § 103(a) is respectfully requested.

There Is No Teaching, Suggestion, or Motivation in the Prior Art That Would Have Led One of Ordinary Skill To Modify the Prior Art References or to Combine Prior Art Reference Teachings to Arrive at the Claimed Invention -

As explained above, the combination of Schindler's List, Matheny, and Blackketter does not teach collecting viewer information without prompting the user for feedback. Matheny teaches a system and method that requires viewer feedback as part of the reward validation and fulfillment process. As described in Matheny, "viewers must provide some feedback to indicate that they watched the commercial before they are entitled to a reward." See Matheny, col. 3, lines 14-30, emphasis added. As such, Matheny teaches a system implemented to require such prompted viewer feedback from the viewer as part of viewer participation in an interactive reward program. This teaching of required viewer feedback in Matheny is directly opposite of and inconsistent with the approach presently claimed, wherein the pending claims specifically recite that, "viewer information is not collected in response to prompted viewer feedback". As such, this teaching in the cited references of requiring viewer feedback cannot be considered to suggest or motivate someone of ordinary skill in the art to implement a system that does not require viewer feedback as presently claimed. Suggestion or motivation cannot be sustained by a system that teaches an opposite approach or teaches away from the claimed invention as Matheny does in this case. Further, the only predictable result that would have been yielded by the combination of references offered in the Final Office Action is a system requiring viewer feedback; because viewer feedback is such an important element of Matheny as described therein. Additionally, any attempt to modify Matheny to not require viewer feedback would result in an inoperable system as detailed below.

Matheny is directed at a system and method for encouraging viewers to watch television programs by providing an incentive program that requires viewer feedback. As described in Matheny,

...viewers are notified that they can receive frequent-flier miles for answering one or more simple questions at the conclusion of the commercial.

To verify that the viewer paid attention to the commercial, the answer to the question may be based on the content of the commercial. A sponsor might ask, for example, that the viewer identify the name of the sponsor or the color of an announcer's shirt. A correct answer indicates that the viewer watched the commercial, and that the viewer is therefore entitled to some reward... (Matheny Abstract) (emphasis added).

In other embodiments, viewers need not provide a "correct" answer, but may be rewarded for merely participating in the interactive program. Such participation may include selecting an icon with a pointing device, pressing one or more buttons on a remote control, or sending an email message to a location identified in the program. (Matheny Col. 2, lines 11-17) (emphasis added).

In accordance with the invention, broadcaster 205 notifies viewers of television set 235 that they may be rewarded for paying attention to a current or upcoming program, typically a commercial. Later, viewers are presented a question, the answer to which is based upon the content of the program. Viewers that provide the correct answer are entitled to the reward. The identities of viewers who provide correct answers to the question are therefore forwarded to server 220, within which is maintained a database of viewers and corresponding earned entitlements. (Matheny Col. 2, lines 55-65) (emphasis added)

The possibility of receiving a reward will entice some viewers to claim rewards without bothering to watch the associated commercial. Thus, in accordance with one embodiment of the invention, viewers must provide some feedback to indicate that they watched the commercial before they are entitled to a reward. In the example of FIG. 2, set-top box 245 presents the viewer with a test question 265 at or near the end to the commercial. The question is based upon the content of the commercial, so viewers who watch the commercial are able to answer the question correctly. In the example depicted as a subsequent video frame 266 of television 235, a reward query 265 prompts the viewer with a query 269 asking the viewer to enter the previously displayed cruise destination into a form field 270. Entering the correct answer in field 270 entitles a viewer to the offered reward. (Matheny Col. 3, lines 14-30) (emphasis added)

Broadcasters may wish to pose questions for which there are no correct answers. For example, a sponsor may wish to ask survey questions. The invention may be adapted to provide rewards to viewers who answer such questions. Further, some viewers may find filling in blanks too cumbersome; thus, other embodiments employ simpler test methods (e.g., multiple-choice or true/false), or reward viewers for merely participating in interactive

programs. Such participation may include selecting an icon with a pointing device or pressing one or more buttons on a remote control. Still other embodiments may demand more information from a viewer, such as by prompting the viewer to send an email message to a location identified in the program, and possibly by requiring the viewer fill out an electronic form. (Matheny Col. 3, lines 31-45) (emphasis added)

As these passages from Matheny indicate and as discussed during several Examiner Interviews, Matheny is directed at a system and method that requires some sort of viewer feedback as part of the reward validation and fulfillment process. As described in Matheny, “viewers must provide some feedback to indicate that they watched the commercial before they are entitled to a reward.” As such, Matheny is designed and implemented to require such prompted viewer feedback from the viewer as part of viewer participation in an interactive reward program. Many of the operations in Matheny are triggered as a result of receiving the required viewer feedback. If such feedback was not forthcoming, Matheny would be rendered inoperable. Thus, for the reasons set forth above, there is no teaching, suggestion, or motivation in the cited art that would have led one of ordinary skill in the art to produce the claimed invention from any combination of the teachings in the cited art. The presently claimed invention would not be a predictable result of any combination of the cited references. Therefore, the Examiner has failed to establish a proper *prima facie* case of obviousness by failing to demonstrate that the claimed invention is predictable, suggested, or motivated by the teachings in the cited references. Thus, reconsideration and reversal of the rejections under 35 USC § 103(a) is respectfully requested.

Summary

For the reasons set forth above, claims 1-10 have been improperly rejected under 35 USC § 103(a) as being unpatentable over any combination of Schindler's List, Matheny, Blackketter, and/or Williams. It is respectfully noted that if an independent claim is nonobvious under 35 USC § 103, then any claim depending therefrom is also nonobvious. See M.P.E.P. § 2143.03. Thus, the independent and the dependent claims presently presented are not obvious for the reasons set forth above. As explained and supported herein, the pending claims were improperly rejected. The purported basis for the obviousness rejections was improperly cobbled together from four inconsistent references that do not teach all claimed elements and would not motivate one of ordinary skill in the art to implement the presently claimed embodiments. The Applicant therefore respectfully requests reversal of the rejections under 35 USC § 103(a) and allowance of the pending claims.

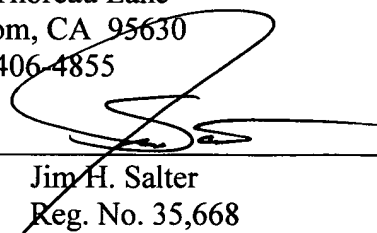
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief, Patents, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8th day of June, 2009.

Jim H. Salter

Name



Signature

8. CLAIMS APPENDIX

1. A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

- receiving a broadcast with embedded information about the broadcast, said embedded information being provided to allow construction of a viewing record of the broadcast, the embedded information including information indicative of one or more sponsors of the broadcast;
- extracting and displaying content from said broadcast without commercial interruption to a viewer;
- extracting said embedded information from said broadcast;
- storing said embedded information;
- collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer, wherein the collected viewer information is not collected in response to prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program;
- sending said stored embedded information and viewer information to a remote computer to allow said remote computer to construct said viewing record; and
- providing the specific incentives to the viewer based on said viewing record, the viewing record including viewer information obtained without prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program, the specific incentives including information indicative of one or more sponsors of the broadcast.

2. A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving a broadcast with information about the broadcast embedded into the broadcast at regular time periods, said information including timestamps each identifying a time slice during which the broadcast is received, the embedded information including information indicative of one or more sponsors of the broadcast;

extracting and displaying content from said broadcast without commercial interruption to a viewer;

extracting said embedded information from said broadcast;

incrementing counters for counting time slices during which said broadcast is received;

storing said embedded information and said counter values;

collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer, wherein the collected viewer information is not collected in response to prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program;

sending said embedded information, said counter values and viewer information to a remote computer to allow a viewing time to be determined; and

providing the specific incentives to the viewer based on said embedded information and the viewer information obtained without prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program, the specific incentives including information indicative of one or more sponsors of the broadcast.

3. A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

embedding information along with the broadcast content, said embedded information including information that allows viewer information to be determined, the viewer information including information indicative of an amount of the broadcast viewed by a remote viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the remote viewer, the

embedded information including information indicative of one or more sponsors of the broadcast; and

broadcasting said content with said embedded information to the remote viewer of the content without commercial interruption, the embedded information enabling a remote computer to retain the information indicative of one or more sponsors of the broadcast, and to determine the viewer information, the viewer information further including a user identifier and the information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives being based in part on the amount of the broadcast viewed by the remote viewer, wherein the viewer information is not determined in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

4. The method of claim 3 further comprising:

obtaining the stored embedded information so as to determine said viewer information; and

sending the links to the specific incentives to said remote viewer based on said viewer information, the viewer information being determined without prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

5. A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

embedding information along with the broadcast content at regular time periods, wherein said embedded information, when collected over time, allows a viewing record of the broadcast to be determined, the embedded information including information indicative of one or more sponsors of the broadcast; and

broadcasting said content with said embedded information without commercial interruption to a remote viewer of the content, the embedded information enabling a

remote computer to retain the viewing record, information indicative of one or more sponsors of the broadcast, and viewer information, the viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the remote viewer, wherein the viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

6. The method of claim 5 further comprising:

providing collected embedded information about said broadcast at a predetermined time; from said collected embedded information, determining a number of time slices during which the broadcast is received by the remote viewer; and sending links to the specific incentives to said remote viewer based on said time slices, the time slices being obtained without prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

7. A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving information representing a viewing record including information related to a viewer's viewing of a broadcast without commercial interruption, the viewing record including information indicative of one or more sponsors of the broadcast and viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer, wherein the viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of viewer participation in an interactive reward program; and

sending the links to the specific incentives to the viewer based on said viewing record including information indicative of one or more sponsors of the broadcast, the viewing record including viewer information obtained without prompted viewer feedback provided by the viewer as part of viewer participation in an interactive reward program.

8. A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving information about a remote viewer's viewing of a broadcast without commercial interruption, the received information including information indicative of one or more sponsors of the broadcast;

receiving counter values representing the number of time slices viewed by the remote viewer;

collecting viewer information including a user identifier and information indicative of an amount of the broadcast viewed by the viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the viewer, wherein the collected viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program;

and

sending specific incentives to the remote viewer based on said information received, including information indicative of one or more sponsors of the broadcast, and said counter values received, said information received being obtained without prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program.

9. A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving information representing a viewing record including information related to a remote viewer's viewing of a broadcast without commercial interruption, the viewing record including information indicative of one or more sponsors of the broadcast, the viewing record further including information indicative of a user identifier and information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the remote viewer, wherein the information representing a viewing record is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program;

searching a database for information about sponsors of the content of said broadcast and the specific incentives offered by said sponsors;

creating a Web page containing links to sponsor incentive websites and to specific incentives based on said database information and said viewing record; and

sending said Web page to said remote viewer.

10. A method for allowing content to be broadcast without commercial interruption, yet letting a sponsor of the broadcast offer incentives to viewers to watch the broadcast, the method comprising:

receiving information representing a viewing record including information related to a remote viewer's viewing of a broadcast without commercial interruption, the viewing record including information indicative of one or more sponsors of the broadcast and viewer information including information indicative of an amount of the broadcast viewed by the remote viewer, specific incentives and links to the specific incentives being associated with the amount of the broadcast viewed by the remote viewer, wherein the viewer information is not collected in response to prompted viewer feedback provided by the remote viewer as part of remote viewer participation in an interactive reward program;

receiving counter values representing the number of time slices during which the broadcast was viewed by said remote viewer;

searching a database for information about sponsors of the content and the specific incentives offered by said sponsors;

creating a Web page containing links to sponsor incentive websites and to specific incentives based on said database information, said viewing record, and said counter values; and

sending said Web page to said remote viewer.

9. EVIDENCE APPENDIX

None.

10. RELATED PROCEEDINGS APPENDIX

None.